

## **REMARKS**

The Examiner's reconsideration of this application is sincerely appreciated.

### **1. Pre-Mature Final Rejection**

Applicant respectfully submits that the final rejection was pre-mature, and requests that the examiner withdraw the finality of the last office action.

### **New Reference**

The examiner made an unsupported obviousness-type double patenting rejection in the first Office Action. In the second Office Action, which was made final, a new and vital supporting reference was first introduced to the obviousness-type double patenting rejection.

### **Fairness Requires Withdrawal of Finality**

Rule 1.113 provides that a second office action may be made final. We are not amending the claims. MPEP §714.12 and Rule 1.116(c) provide that amendments after final actions may be admitted upon showing of good and sufficient reasons why they are necessary and were not presented earlier.

Fairness requires that applicant have an opportunity to respond to the first inclusion of a reference necessary to the rejection. This is especially so in this case, as explained more fully below, because the combination of the primary reference, applicant's prior patent, and the supporting reference, U.S. Pat. No. 6,413,162 (the '162 patent, or Baerlocher patent) produce a nonsensical result which is not the applicant's invention. In this case the Baerlocher reference not only does not support the obviousness-type double

patenting rejection, but actually supports traversal of the rejection. Applicant has not been given a chance to address the new rejection containing the new reference.

Applicant respectfully requests that the examiner withdraw the finality of the rejection of the last Office Action.

## **2. Priority Claim Amendment**

### **The Amendment**

The specification is amended by adding a first sentence to the specification that claims the benefit of priority. This is consistent with 35 U.S.C. § 120. The current application is a continuation-in-part application based on U.S. patent application Serial Number 10/704,525 filed November 4, 2003 (now U.S. Pat. No. 6,896,259) as indicated in the original papers submitted on the date of filing. The continuity chain of applications was noted in application Serial Number 10/704,525.

### **Petition and Surcharge Not Required**

A petition and surcharge are not required to amend the specification to add applicant's priority claim. This is because the information claiming benefit of priority was contained elsewhere in the application and was recognized by the Office as shown by its inclusion on the filing receipt (MPEP 201.11) and the Patent Application Publication.

### **Documentary Support**

Applicant provides three documents that show the Office was aware of and acknowledged applicant's claim to priority. They are the following: a copy of the original

Utility Patent Application Transmittal; a copy of the original Filing Receipt; and a copy of the first page of the Patent Application Publication.

(1) Utility Patent Application Transmittal

The "Utility Patent Application Transmittal" dated March 3, 2004 shows under part 18, that the box for Continuation-in-part (CIP) was checked, and the "of prior Application No.:" references application "10/704,525", see Attachment 1 attached hereto and incorporated herein by this reference.

MPEP 201.11(III)(D), titled "Reference Must Be Included in the Specification or an Application Data Sheet (ADS)" states:

"If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaraction or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt."

(Emphasis Added)

(2) Filing Receipt

The filing receipt applicant received shows that the Office recognized the applicant's priority claim. The Filing Receipt which was mailed on May 26, 2004 acknowledges the applicant's priority claim under the heading "Domestic Priority data as claimed by

applicant". The filing receipt shows, "This application is a CIP of 10/704,525 11/04/2003", see Attachment 2 attached hereto and incorporated herein by this reference.

(2) Patent Application Publication

Patent Application Publication also supports that the Office recognized the applicant's priority claim. The application was published on May 5, 2005, prior to the normal 18-month period, and the "Patent Application Publication" shows on its first page: "(63) Continuation-in-part of application No. 10/704,525, filed on Nov. 4, 2003.", see Attachment 3 attached hereto and incorporated herein by this reference.

The priority claim was timely made, the application numbers, relationships of the applications are properly noted, and the filing dates are noted. These have been acknowledged by the Office; thus, it is proper to allow correction of the priority claim by amendment to the specification.

**Petition For Unintentionally Delayed Benefit Claim**

Despite applicant's belief that the Office recognized its priority claim, and in the alternative, a surcharge under 37 CFR 1.17(t) has been paid, and a Petition has been filed with the Commissioner for Patents (a copy of which is enclosed) for Unintentionally Delayed Benefit Claim. Applicant is doing this because of uncertainty about how the Office treats a situation such as this where the priority claim has been acknowledged but the information related to the priority claim is not full and specifically repeated in a single reference.

## **Specific Concern**

Applicant's specific concern is with that portion of the above amendment which relates to the multiple prior applications which are expressly referenced in Application No. 10/704,525 (now Pat. No. 6,896,259).

It is clear that the reference to Application No. 10/704,525 is correctable without a petition or surcharge by amendment of the specification. It is not as clear that the remainder of the continuity chain may be corrected without a petition and the payment of the surcharge. Thus, out of an abundance of caution, and though it should not be required, a Petition has been filed and the surcharge has been paid related to the continuity chain referenced in Application No. 10/704,525 (now Pat. No. 6,896,259).

### **3. Obviousness-Type Double Patenting**

The claims stand rejected based upon obviousness-type double patenting. The rejection is based upon applicant's prior U.S. Patent No. 5,788,230 (the '230 patent or the "prior patent") in view of U.S. Patent No. 6,413,162 (the '162 patent or the "Baerlocher" patent); and provisionally upon co-pending application Serial No. 10/704,525, now Pat. No. 6,896,259 (the '525 application or the co-pending application). Presumptively the provisional rejection is no longer provisional, since the '525 application has now issued as a patent.

Reconsideration of these rejections is respectfully requested.

## **Not Obvious to Combine the References**

The technology in the Applicant's prior patent and the Baerlocher patent are so substantially different that it would not be obvious for one of ordinary skill in the art to combine the references.

The applicant's prior patent relates to pachinko machines. The Baerlocher patent relates to traditional slot machines with spinning reels having symbols on the faces of the reels. The probability of displaying a symbol on a slot machine is fixed due to the physical nature of the symbol reel. This is not comparable to applicant's invention.

Applicant's invention uses a symbol selector. The symbol selector controls the odds of a specific symbol being selected and controls the feature(s) to which the vast number of symbols may be associated and/or by which the symbol may be displayed.

The frequency of selection for specific symbols, or even each symbol, can be different or varied by the programming of the symbol selector. Also, the frequency of selection of a symbol may be further varied by external influences. Such as in the prior patent where the movement of the ball on the playing field may influence the selection of the symbol. Unlike the prior patent the detectors claimed in the application do not influence symbol selection.

The current application does not disclose a physical limitation that requires symbols to be selected with the same probability of selection, as is the case for the symbols on the slot machine reels. Whatever frequency of selection the symbol selector establishes for a given symbol, association of that symbol with one or more of the detectors will not change or influence the frequency with which that specific symbol will be selected. Nor will the

detector influence how often that specific symbol will be associated with any given the detector or range of detectors. Also, the frequency of symbol selection does not vary from game to game, as is the case in the co-pending application.

The current application's approach has several advantages. The symbol set size can approach infinity, a symbol set which is vastly larger than is possible to any practical degree in a spinning reel type slot machine. The symbol set can be this large without requiring excessive maintenance, components, or space. The frequency of selection of a specific symbol can be varied in relationship to the frequency of selection of any or all other symbols. Each symbol may have its own specific frequency of selection. This is not a fixed probability of selection, consistent for all symbols, which is fixed by the number of faces on a spinable reel. This is a nearly limitless variability of selection.

### **Combination of Patents Produces Nonsensical Results**

The '230 patent teaches the selection of symbols for display on the machine's payline based, at least in part, upon the movement of the ball on the playing field. The specific manner of selection varies from game to game.

The Baerlocher patent teaches having truly random events in which the odds of selection of a symbol are fixed by having the same number of the same symbols on each spinable reel.

The current application is incongruent with these teachings. The invention of this application is not made obvious by the Baerlocher and the '230 patent. The combination of these references suggests the symbol selector could associate the same number of the

same symbol, for example the symbol "A", with each detector. By this association of the same number of the symbol "A" with the detectors, the odds of selecting symbol "A" are now fixed, and the odds of selecting any other symbol are also fixed. That is, this association of "A" symbols with the detectors also causes the odds of selecting a "B" symbol, or any other symbol, to be the same odds as selecting symbol "A". This simply does not make any sense.

The claim language of the application specifically allows for the possibility that the odds of selecting "A" may not be the same as the odds of selecting "B", and further that the association of any symbol with the detectors does not influence, change or fix the odds of selecting that symbol or any other symbol.

### **Inventions Patentably Distinct**

The applicant's prior patents and the cited reference, Baerlocher, do not show the inventions of the current application to be obvious. Therefore, the inventions of this application are patentably distinct. The rejections based upon nonstatutory obviousness-type double patenting are inappropriate. Among the distinctive features of the operation of the symbol selector is that the detectors having no influence upon the frequency with which any given symbol is selected for association with a detector, or with any detectors. Further, the symbols are associated with the detectors, they are not displayed with or by the detectors.

**4. Request For Continued Prosecution**

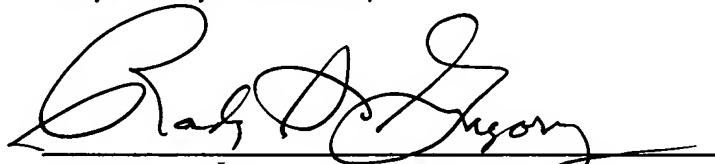
The applicant has filed a request for continued prosecution. This Response to the May 16, 2005 Office Action is Submission required by the rules governing a request for continued prosecution. 37 CFR 1.114

This Request for Continued Prosecution has been made due to the pre-mature Final Rejection to ensure the applicant's responses are considered, and in-part because applicant has filed a Petition to Allow Unintentionally Delayed Benefit Claim.

Given the above amendment to the specification and the argument regarding the inappropriateness of the rejections, applicant respectfully requests that all claims be allowed to put this application in condition for allowance.

Respectfully Submitted,

Date: Nov. 16, 2005



Randy A. Gregory, Reg. No. 30,386

Enclosures: Attachment 1 - Copy of the original Utility Patent Application Transmittal.  
Attachment 2 - Copy of the Filing Receipt mailed May 26, 2004.  
Attachment 3 - Copy of the Patent Application Publication.  
Petition to Allow Unintentionally Delayed Benefit Claim - courtesy copy  
Request for Continued Prosecution - courtesy copy  
One-Month Extension Fee - courtesy copy